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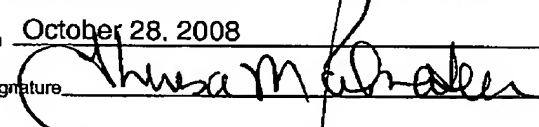
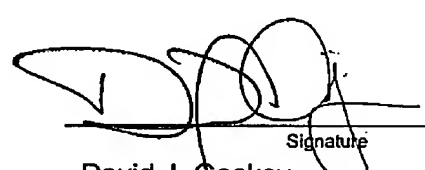
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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		60469-093PUS1;00005171US	
CERTIFICATE OF FACSIMILE I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>October 28, 2008</u> Signature <u></u> Typed or printed name <u>Theresa M. Palmateer</u>		Application Number <u>10/585,386</u>	Filed <u>07/06/2006</u>
		First Named Inventor <u>Carl Q. Howard</u>	
		Art Unit <u>3651</u>	Examiner <u>Hess, Douglas A.</u>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>37,139</u> Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p> Signature <u>David J. Gaskey</u> Typed or printed name <u>(248) 988-8360</u> Telephone number <u>October 28, 2008</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Carl Q. Howard
Serial No.: 10/585,386
Filed: 07/06/2006
Group Art Unit: 3651
Examiner: Hess, Douglas A.
For: DEVICE TO REDUCE NOISE TRANSMISSION THROUGH
THE GAP BETWEEN ESCALATOR STEPS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests pre-appeal brief review of this application because there is no *prima facie* case of obviousness against any of Applicant's claims.

**The rejection of claims 1-3, 5-11 and 16-25
under 35 U.S.C. §112 must be withdrawn.**

The Examiner's rejection misapplies the law. 35 U.S.C. §112, second paragraph, requires that a claim be clear and particular to point out the claimed subject matter. It is clear from the claims that Applicant is claiming a combination of steps and sound transmission reducing features. There is no requirement for Applicant to recite additional structure when the recited elements have a clear structural and functional relationship. Applicant's use of passenger conveyor system in the preamble of the claims does not in any way require Applicant to recite any portion of such a system that Applicant does not wish to claim. One skilled in the art would clearly understand what the claims mean and, therefore, they do particularly and distinctly recite

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the claimed subject matter sufficient to satisfy the requirements of 35 U.S.C. §112, second paragraph. The rejection must be withdrawn.

**The rejection of claims 1-3, 5-11 and 16-25
under 35 U.S.C. §103 must be withdrawn.**

The *Soldat* reference does not establish a *prima facie* case of obviousness against any of Applicant's claims. The brush 3 of the *Soldat* reference may possibly be interpreted as a sound transmission reducing member but there still is nothing whatsoever to suggest in any way how a separate sound insulating material that is distinct from the sound transmission reducing member (as recited in claim 1) would be supported on an underside of the steps in the *Soldat* reference. Without that, there is no possible *prima facie* case of obviousness.

There is nothing in the *Soldat* reference that in any way provides any basis for adding a sound insulating material to the arrangement of that reference. For example, how would a separate sound insulating material possibly enhance the cleaning capability of *Soldat's* brush? Such a modification of the reference can only be explained by using Applicant's disclosure and claims and hindsight reasoning. That is not permitted when attempting to manufacture a *prima facie* case of obviousness. There must be some reason for making the modification suggested by the art or the knowledge of a skilled artisan. There is nothing whatsoever in the record that in any way suggests how the *Soldat* reference could be or should be modified in such a manner. Therefore, there is no *prima facie* case of obviousness against claim 1.

Regarding claims 16 and 21, the sound transmission reducing member is a part of one of the steps and made of the same material as the one of the steps. It is impossible to modify the *Soldat* reference to make it consistent with these claims. The brush 3 of the *Soldat* reference cannot be the same material as the material of the steps. If it were modified in that way, it would no longer operate as the brush 3 of the *Soldat* reference is intended to operate. If the brush 3

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were changed to be the same material as that of the steps, it would no longer be a brush for cleaning purposes.

Such a modification of the *Soldat* reference is not permitted as explained in MPEP 2143.01(V) and (VI). A proposed modification to a reference that interferes with its ability to perform its intended function or renders it incapable of performing its intended function cannot be made. Here the Examiner is suggesting to change the brush 3 by making it out of the same material as the steps (e.g., metal). If one were to do that, the brush 3 would cease to be the kind of brush disclosed in *Soldat* and it would cease to operate as it is intended to operate. Therefore, it is impossible to modify the *Soldat* reference in any way to attempt to manufacture a *prima facie* case of obviousness against claims 16 or 21.

None of Applicant's claims can be considered obvious. The rejections under 35 U.S.C. §103 must be withdrawn.

Request for Specific Indication

Applicant believes that the Panel Decision in response to this request should be that all rejections will be withdrawn. In the event that the Panel decides for some reason that this case should proceed to the Board, Applicant respectfully requests an indication regarding any claims that the Examiner would consider allowable so that Applicant can make an informed decision on further prosecuting this case.

Respectfully submitted,

Dated: October 28, 2008

CARLSON, GASKEY & OLDS

By: 

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